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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,015	12/20/1999	DIETMAR EGGERT	F71989US	3122

23720 7590 09/02/2003

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EXAMINER

HUYNH, KIM NGOC

ART UNIT PAPER NUMBER

2182

DATE MAILED: 09/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application No.

09/468,015

Applicant(s)

EGGERT ET AL.

Examiner

Kim Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/31/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by Waga (US 5,529,831). Waga discloses an integrated circuit having an inductor 23 in a coil shape (Figs. 11) to form a low pass filter as illustrated in Fig. 10 with plurality of ESD devices 26 on a IC die/substrate.
3. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Lee (US 5,831,331) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lee (US 5,831,331) in view of Waga (US 5,529,831).

a. Lee discloses an integrated circuit essentially as claimed: a substrate 302, plurality of conductive layers 1-3 shape of a coil turn interleaved with a plurality of insulation layers (col. 2, ll. 36-39 and col. 4, ll. 5-16), plurality of vias (114, 116) connecting adjacent to the coil turn. Though Lee does not disclose a plurality of ESD devices connecting to the corresponding coil turn, please note it is inherent that capacitors are formed between the conductive layers according to the laws of physics, and thereby forming a plurality of ESD devices. This is in the exact manner as applicant's embodiment and Waga.

b. As for the shape of the coil and the type of metal, these are unremarkable and conventional modifications which are well within the ability of one having the ordinary skill in the art as matter of choice to utilize any type of metal or shape of the inductor loop to form the integrated inductor as long as it provide an inductor structure which can be used in the circuit of ^{Waga} Ker to operate with the ESD clamp to provide ESD protection of the circuit in absence of persuasive evidence that a particular shape or type of metal is significant. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It is further evidence by applicant's own various embodiments as claimed.

Response to Arguments

4. Applicant's arguments filed 3/31/03 have been fully considered but they are not persuasive.

a. Applicant argues that Waga does not disclose the plurality of ESD devices, the examiner respectfully disagrees; the ESD devices are indicated by capacitors 26. The examiner also disagrees with applicant's argument that since Waga does not use the term ESD devices, the capacitors 26 of Waga do not function as ESD devices.

Regardless of the use of the capacitor 26 of Waga, please note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See

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In re Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this instant, please note that the thin film device in Fig. 10 of Waga provides the identical structure of Fig. 2 of applicant's own invention and claimed limitation. Please also applicant's own admission that ESD devices can be in various forms including Zener diodes, capacitors and other controlled breakdown or surge filtering devices (p.2, ll.12-14).

b. Applicant argues that Lee does not disclose the plurality of ESD devices, please note the examiner explains that though Lee does not disclose a plurality of ESD devices connecting to the corresponding coil turn, the ESD or capacitance formed between the conductive layers are inherent according to the laws of physics, and thereby forming a plurality of ESD devices.

The examiner further points out that this property are further support by the structure of the thin film device as disclose in Waga and also is in the exact manner as applicant's embodiment. Please note Figs. 1-4 of Lee show the identical structure of applicant's own invention (Fig. 4). Again applicant seems to argue that Lee does not read on the claimed invention just because Lee does not use the same terminology as preferred by applicant. The examiner again respectfully disagrees with this line of argument.

Conclusion

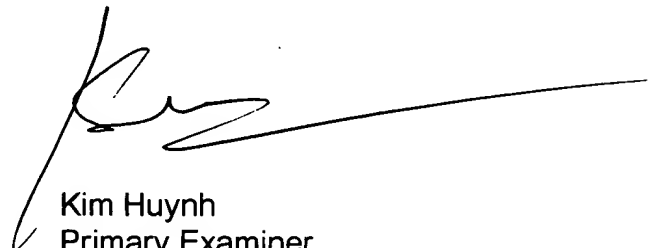
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (703) 308-1678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Kim Huynh
Primary Examiner
Art Unit 2836

KH
August 28, 2003